

REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1-25 are pending in this application. In particular, claims 1, 12, 18, 24 and 25 have been amended and claims 2-11, 13-17 and 19-23 have been maintained in their previous form. No new claims have been added. Applicant asserts that the amended claims are fully supported by the disclosure of the application as filed, and as such, do not introduce new matter. The status of all the pending claims is reflected in the above listing.

I. Claims Rejected Under 35 U.S.C. § 102

Claims 1-3, 5-6, 9-12 and 14-22

The Examiner has rejected claims 1-3, 5-6, 9-12 and 14-22 under 35 U.S.C. § 102(e) as being anticipated by Webb (U.S. Patent Application No. 2003/0057648). These rejections are moot as claims 1, 12 and 18 have been amended.

“Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Webb fails to disclose at least one element recited in amended independent claims 1, 12 and 18.

As described and claimed in the present application, a player may engage in an optional side wager in a side wager area 120 adjacent a primary wager area 110 (fig. 1 and page 8, paragraph [0031]). The optional “side wager is based on the initial three cards received by each participating player.” Id. The maximum payout is provided to the player having three initial cards each having a value of three (three 3’s), while other possible payouts are listed in a payout table (fig. 3). Accordingly, claim 1 has been amended to recite: “said side wager dependent upon a poker ranking defined by three or more player’s cards,” claim 12 has been amended to recite: “said side wager is dependent upon a poker ranking defined by three or more of each player’s cards,” and claim 18 has been amended to recite “said side wager is dependent upon a poker

ranking defined by three or more player's cards." Each claim has further been amended to recite that each player's hand comprises three or more cards.

Webb, in contrast, fails to disclose or suggest determining a side wager based on three or more of the player's cards. Before cards are dealt, a player in Webb can place a primary Blackjack wager and an optional 3-card Poker side wager (abstract; page 1, paragraph [0009]; page 2, paragraph [0022]). The player is provided with two cards while the dealer is provided with one. The strength and outcome of the side wager is determined based on the two cards dealt to a player and a dealer's face-up card, with winning combinations shown in the table on page 3. Id. Accordingly, the side wager in Webb is based on two cards from the player's hand and one card from the dealer's hand, whereas the claims as amended recite determining the side wager based on three or more of the player's cards. In fact, the game in Webb is modified Blackjack so in order to ensure that three cards are available to resolve the side wager, the dealer's card must be used. That is, in Blackjack, if a player is dealt two cards totaling 17 or more or lesser two-card totals dependent upon a dealer's face-up card, the player may only play two cards (i.e., stand on two cards). Therefore, the present invention claims a player's hand having three or more cards. As such, Webb fails to disclose a player's hand formed of at least three cards (as described above, Webb's Blackjack game inherently teaches away from a requirement of three or more player's cards) and a side wager premised on the three or more player's cards as recited in amended independent claims 1, 12 and 18.

As set forth above, Webb does not expressly or inherently disclose each and every element of amended independent claims 1, 12 and 18 and the rejection of these claims under Section 102 should be withdrawn. Since Webb fails to expressly or inherently disclose each and every element of claims 1, 12 and 18, and since claims 2, 3, 5, 6, 9-11, 14-17 and 19-22 depend from add further limitations to claims 1, 12 and 18, the rejection of these claims is also overcome. Therefore, claims 1-3, 5-6, 9-12 and 14-22 are patentably distinct as written and the rejection of these claims under Section 102 should accordingly be withdrawn.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 4, 7-8, 13 and 23-25

The Examiner has rejected claims 4, 7-8, 13 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Webb. As discussed above, Webb does not disclose or teach all of the elements recited in amended independent claims 1, 12 and 18. See discussion supra. Therefore, Applicant respectfully asserts that claims 1, 12 and 18 are not obvious over Webb. The arguments made above with respect to claims 1, 12 and 18 regarding the applicability of Webb apply with equal force here. See discussion supra.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03.

For the reasons above, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has not been met because Webb fails to expressly or inherently teach or suggest each and every element of amended independent claims 1, 12 and 18, namely, there is no motivation or suggestion in Webb for determining a side wager based on three or more of player’s cards wherein each player’s hand comprises at least three cards. In re Royka. Accordingly, since claims 1, 12 and 18 are not obvious under Section 103, then any claims depending therefrom is nonobvious, namely claims 4, 7, 8, 13 and 23. In re Fine. Thus, claims 4, 7, 8, 13 and 23 are patentably distinct as written and the rejection of these claims under Section 103 should accordingly be withdrawn.

In addition, independent claims 24 and 25 are not obvious in view of Webb because Webb does not disclose or teach all of the elements recited in these claims. Specifically, claim 24 has been amended to recite: “the side wager dependent upon a poker ranking defined by three or more of the player’s cards,” while claim 25 recites:

"resolving each player's side wager wherein the side wager is dependent upon a poker ranking defined by each player's first three cards." The arguments made above with respect to claims 1, 12 and 18 regarding the applicability of Webb apply with equal force here. See discussion supra.

For the reasons above, the Examiner's burden of factually supporting a *prima facie* case of obviousness has not been met because Webb fails to expressly or inherently teach or suggest each and every element of claims 24 and 25, namely, there is no motivation in Webb to teach or suggest determining a side wager based on three or more of the player's cards. In re Royka. Accordingly, these claims are patentably distinct as written and the rejection of these claims under Section 103 should accordingly be withdrawn.

III. Conclusion

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

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